REMARKS – General

The 35 USC § 103 Rejection of Claims on Jotikasthira, Jones et al and Yuen Is Overcome

Applicant requests reconsideration of this rejection for the following reasons:

(1) There is no justification in **Jotikasthira**, **Jones** and **Yuen**, or in any other prior art separate from Applicant's disclosure, which suggests that these references be combined, in a new and non-obvious way in the manner proposed [Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966)].

(2) Even if **Jotikasthira**, **Jones** and **Yuen** were to be combined in the manner proposed, the proposed combination would not show all of the novel features of Applicant's claims [Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966)].

(3) These novel features Applicant's claims produce new and unexpected results and hence are unobvious and patentable over these references [Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966)].

The References And Differences Of The Present Invention Thereover

Prior to discussing the above points, Applicant will first discuss the cited references and the general novelty of the present invention and its un-obviousness over the references.

(1.0) Jotikasthira teaches a "`device and method for handling and transferring data associated with a main broadcast program (e.g. music names, singer names and advertisement) from a broadcast` `station (radio, television, etc.) or a cable television set top box.`".

(1.1) Considering **Jotikasthira** in its entirety, it is clear that **Jotikasthira** teaches a device to "`handle and transfer`" data associated with a broadcast signal, *not* using any form of teletext, in order to record the information for either later exchange with another electronic device, or to purchase a product at an advertised location (see Abstract and paragraphs [0005], [0007], [0008], [0018] , [0019] , [0029] , [0030] , [0032] , [0033] , [0034] , [0036] , [0037] , [0039] , [0040] , [0043] and [0047]).

(1.2) The action, i.e. the verbs "to handle" and "to transfer" data associated with a main broadcast program, is understood by Applicant, as one of ordinary skill in the art, to capture, store and transfer relevant broadcast associated data to another device (Abstract, Fig. 1, Fig. 4, Fig. 5and paragraphs [0001], [0002], [0005], [0006], [0007], [0008], [0017], [0018], [0019], [0022], [0028], [0029], [0030], [0031], [0032], [0033], [0034], [0036], [0037], [0040], [0042], [0045] and [0046]). This simple, and widely discussed function / action in **Jotikasthira** clearly does *not* include contacting a representative of the advertisement by transmitting the contact information via teletext embedded in the advertisement's TV signal as claimed by Applicant. Applicant now addresses this conclusion by further studying **Jotikasthira** in detail as follows:

(1.3) **Jotikasthira** teaches that "`a consumer wants` *`to record data`* `(e.g. music titles, singers' name, product names, advertisement and other data) to buy products or to transmit to other people`" (emphasis added) para. [0005], or "`the user` *`may purchase a particular product`* `if the captured data is advertisement information such as a product name, price, and` *`location`* `for purchasing the product(s)`" (emphasis added) para. [0038]. Only one other mention of "`purchasing`" products is made in para. [0047]. Nowhere is it taught in **Jotikasthira** that a user can *contact a representative of an advertised product or service* using the captured, handled and transferred broadcast data. Applicant's premise is that a television

(TV) viewer may not want to "`purchase`" something that is advertised, but simply gather further information either before making a purchase, or simply to satisfy a curiosity. Furthermore, many TV advertisements don't enable a viewer to purchase anything directly. Examples of such advertisements include information disseminated by companies who are lobbying government and the public, as well as public awareness advertisements such as the dangers of smoking, drinking-and-driving, etc. Furthermore, a TV viewer may decide not to purchase a product upon making further inquiries, i.e. gathering information *unavailable* in the advertisement, after *contacting a representative of an advertised product or service.*

(1.4) Clearly **Jotikasthira** teaches going to a "`location`", i.e. a "`place, a building or locality for a special purpose`" (*The Merriam-Webster Dictionary*, ISBN-10 0-87779-930-X) to purchase the advertised product. As mentioned previously **Jotikasthira** further teaches exchanging data with another electronic device, i.e. a **Jotikasthira** "`PHMM`" enabled device, which is similar in principle to jotting down information on a notepad page and giving the page to another person.

(1.5) In other words, **Jotikasthira** teaches, in effect, an electronic notepad system in which associated product data transmitted in a *non-teletext* broadcast signal is "`captured`" and "`stored`" in a "notepad" device, i.e. a "`PHMM`". "Pages" from this "notepad" can then be shared with other people, i.e. transferred to another **Jotikasthira** "`PHMM`" enabled device, or used to go to a *location* to purchase the noted product(s).

(1.6) A clear and non-obvious difference *does* exist between *contacting* a representative of an advertisement and *purchasing* the advertisement's product at a specified *location.*

(1.7) As mentioned previously above in section (1.3), some advertisements do not even offer a product or service to be purchased, but do offer the viewer *contact* information (e.g. a phone number to call to speak with a representative, or a web site) to obtain more information. Further examples of this non-purchasable advertisement include a public service message in anti-drug use, the upcoming 2009 conversion to digital broadcast TV in the USA, voter registration, forthcoming TV programs, etc.

(1.8) Examiner states in the Office Action (page 3, para. 4; page 8, para. 2; page 14, para. 4; and page 15, para. 5) that "**Jotikasthira** discloses that the data can include *location information* for *purchasing* a product that is advertised. *The examiner acknowledges that location information can also be used to contact a representative of an advertisement*" (emphasis added).

(1.9) Applicant respectfully disagrees with the Examiner's broad interpretation of **Jotikasthira** 's "location data" use. **Jotikasthira** clearly does *not* include contacting a representative of the advertisement as claimed by Applicant's invention.

(1.9.1) The word "**location**" is defined in a dictionary (*The Merriam-Webster Dictionary*, ISBN-10 0-87779-930-X) as follows:

a) "SITUATION, PLACE"
b) "PLACE" is further defined as "a building or locality used for a special purpose" and
c) "SITUATION" is defined as "LOCATION, SITE".

(1.9.2) The word "**contact**" is defined in a dictionary (*The Merriam-Webster Dictionary*, ISBN-10 0-87779-930-X) as follows:

a) "ASSOCIATION, RELATIONSHIP; also : CONNECTION, COMMUNICATION".

(1.10) Clearly "contact information", i.e. a phone number or a web site, as claimed by Applicant does *not* necessarily include a "location", i.e. a site/place where a user can *purchase* the advertised product as taught in **Jotikasthira**. Furthermore, **Jotikasthira** *never* mentions a phone number being part of a "location" for "`purchasing the product(s)`" (para. [0038]). As for a web site being a point of contact retrieved in the advertisement's data, the only mention of "`web`" in **Jotikasthira** is in connection to a broadcasting source, i.e. "`web radio or web broadcast`" [para. 0034].

(1.11) Applicant traversed a random sampling of USA television advertisements and their associated, i.e. displayed contact information. See the Table 1 below.

Ad Name	**Product/Service**	**Phone #**	**Web Site**	**Total Bytes**
Grill Daddy	Grill brush for $14.95	1-800-419-7396	www.grilldaddybrush.com	70
PetMeds	Pet medications	1-800-pet-meds	www.1800PetMeds.com	55
Liberty Mutual	Home insurance	1-800-4-Liberty	www.libertymutual.com	64
Chase Visa	Credit card		Chase.com/freedom	38
Red Lobster	Seafood restaurant		RedLobster.com	43
Expedia Travel	50% off hotels		Expedia.com	39
Farmer's Insurance	Identity Shield	1-800-farmers	Farmers.com	57
Weight Watchers	Eat right, live healthily	800-651-6000	www.weightwatchers.com	75
Subaru	$1,500 cash back	1-800-782-2783	www.subaru.com	50
NAB	TV Converter Box	1-888-DTV-2009	DTV2009.gov	42
Jay Leno	The Tonight Show		www.nbc.com/tonightshow	46

Table 1

(1.12) Clearly **Jotikasthira** teaches away from Applicant's unexpected and non-obvious use of advertisement teletext associated data *to contact a representative* of the displayed advertisement.

1.13) Furthermore, Applicant proposes that if **Jotikasthira** had intended the new and non-obvious use of *contacting an advertisement's representative via embedded teletext data* as claimed by Applicant, **Jotikasthira** would have mentioned it, as **Jotikasthira** *clearly* mentions many other alternatives, etc. which are commonly known to one of ordinary skill in the art. For example:

- **Jotikasthira** lists a variety of data associated with broadcast programs "such as advertisements, music titles, singers' names" (see para. [0003], [0005], [0019], [0029]);
- a hand-held device "for example, a television remote control or other remote control device, car key, personal digital assistant (PDA), mobile phone, or pager" (see para. [0011], [0031, [0043]]);
- a data source "such as satellite equipment in a broadcasting station or on a relay device, such as receivers on a television or radio" (see Abstract, para. [0012], [0019], [0028], [0031], [0034]);
- the input/output unit "is a one button manual control which is used as an interface for a user to send commands. It will be appreciated that other means may be employed to accomplish the same function, such as a bar, lever, or handle. In addition, a touch sensitive surface or voice activated binary input/output unit may also be employed" (see para [0030]);
- a display unit "such as but not limited to a liquid crystal display (LCD), plasma, and/or light emitting diode (LED)" (see para. [0029], [0035], [0039]), etc.

(2.0) Applicant now considers the cited prior art **Jones et al**: **Jones et al** teaches an "Apparatus and Method for Generating Product Coupons in Response to Televised Offers" (Patent Title), i.e. a "system for generating a token such as a product coupon or a ticket that is offered to a television viewer through a televised offer, such as a product advertisement" [col. 2, lines 47-50].

(2.1) **Jones et al** teaches using the analog VBI section of a TV signal, primarily as closed captioning (i.e. line 21 in the VBI), such that advertisers "`may embed a coupon identifier [...] in the video signals of their advertising programming using the method known in the art for providing closed-captioned text for the hearing-impaired`" [col., 4, lines 60-65].

(2.2) **Jones et al** teaches that pertinent viewer information, i.e. the "`coupon packet`" [col. 5, line 14; col. 6, lines 43-67, col. 7, lines 1-16 and Fig 8.] is embedded in the signal transmitted to the viewer [col. 6, lines 17-41] via a *real-time* computer system that **Jones et al** call a "`coupon subsystem 14`", which is resident at a "`cable television station`" [Fig. 1; col. 4, line 33; col. 4 lines 11-27].

(2.3) The **Jones et al** embedded "`coupon packet`" is then transmitted "`on a data channel of cable network 16`" [col. 5, lines 21-25; col. 7, lines 17-27; col. 8, lines 44-55; col. 13, line 67; Fig1; Fig 2; Fig 5 and Fig 6].

(2.4) **Jones et al** teaches the insertion of the associated token information in *real-time*, i.e. via the "`coupon subsystem`" [col. 5, lines 21-25; col. 7, lines 17-27; col. 8, lines 44-55; col. 13, line 67; Fig1; Fig 2; Fig 5 and Fig 6].

(2.5) The *real-time* insertion of the "`coupon packet`" teaches away from Applicant's claimed invention. Applicant's claimed invention does *not* insert pertinent contact information in *real-time*. This unexpected and non-obvious teaching of Applicant's invention is important because it does not require a system such as **Jones et al's** *real-time* "`coupon subsystem`" and the widely described need in **Jones et al,** for a dedicated cable "`data channel`" [col. 5, lines 21-25; col. 7, lines 17-27; col. 8, lines 44-55; col. 13, line 67; Fig1; Fig 2; Fig 5 and Fig 6].

(2.6) **Jones et al** do teach another embodiment [Fig. 4], which is described as "... `may be particularly useful if` *`no data channels are available`*`. For example, it can be used to provide coupons to viewers of` broadcast, i.e., radiated transmission, television if a cable television system is unavailable." (Emphasis added) [See col. 11, lines 8-10]. **Jones et al** go on to teach that in "this embodiment, the portion of the present invention at the broadcasting station (not shown) operates in a manner similar to that of the cable television station described above with respect to FIG. 1, *but it does not have a coupon subsystem 14*." (Emphasis added) [See col. 11, lines 12-15].

(2.7) The stated fact that this embodiment [Fig. 4] of **Jones et al** "does not have a coupon subsystem 14" [col. 11, line 15] is important.

(2.8) Previously **Jones et al** teaches the use of the "coupon subsystem" to insert the pertinent "coupon packet" into the transmitted signal [col. 5, lines 21-25; col. 7, lines 17-27; col. 8, lines 44-55; col. 13, line 67; Fig1; Fig 2; Fig 5 and Fig 6]. In this embodiment [Fig. 4], i.e. one that "does not have a coupon subsystem 14", **Jones et al** teaches that the "Coupon processor 138 uses the coupon identification number to form an address or pointer. Coupon processor 138 uses the pointer to read *coupon information 140 from a coupon database memory 142*." (Emphasis added) [See col. 11, lines 47-50]. The "coupon database memory 142" is resident at the viewer's location [Fig. 4; col. 11, line 50; col. 12, line 33].

(2.9) **Jones et al** then goes on to teach that the "coupon information 140" which is "organized into multiple records, *each corresponding to a coupon*. The fields of *coupon information* in each record may include any of the information described above with respect to FIG. 2, such as an availability window, an ASCII-encoded universal product code (UPC) number, a demographic information field, a numeric image length in bytes, and an image field having the number of bits specified by the image length." (Emphasis added) [See col. 11, lines 52-58].

(2.10) The "`coupon information`" is obviously critical in implementing this embodiment of **Jones et al**. [Fig. 4].

(2.11) Applicant could not find any teaching in **Jones et al**, for this embodiment [Fig. 4], whereby this "`coupon information`" is updated in the "`coupon database memory 142`" [Fig 4; col. 11, lines 8-67 and col. 12, lines 1-48].

(2.12) Updating "`coupon information`" is *critical* in a system that teaches a viewer's interaction with TV advertisements, because the broadcasting of advertisements does *not* remain static, i.e. TV ad's are broadcast and change frequently over time.

(2.13) **Jones et al** do teach in another embodiment, i.e. one in which a "`data channel`" is available [see descriptions of Fig. 1; Fig. 2; Fig. 3; Fig. 5; Fig. 6], how the "`Demographic switch 120`" is installed at the viewer's location [col. 3, lines 1-4]. The "`demographic switch`" data is described as being part of the transmitted "`coupon packet`" in the available "`data channel`" embodiment [Fig. 1, Fig. 2, Fig. 3, Fig. 5, Fig. 6], as well as being stored in the subscriber unit [col. 8, lines 64-67 and col. 9, lines 1-15] so that a "`match`" [col. 8, line 66; col. 9, lines 21-67] can be executed to determine whether or not to display the transmitted "`coupon`" [col. 8, lines 56-67; col. 9, lines 1-20].

(2.14) It would be impossible to *pre-determine every* single possible advertisement that would *ever* be transmitted to a television viewer and hence *pre-populate* the viewer's "`coupon database memory 142`" with "`coupon information`" embodiment [Fig. 4] using the method described above in section (2.13). Clearly **Jones et al** does *not* teach a method / function to update the "`coupon database memory 142`" in *real-time* for this embodiment [Fig. 4] to work practically.

(2.15) Applicant respectfully asserts that the **Jones et al** non "`data channel`" embodiment *cannot* function in the world of ever-changing TV advertisements, and more importantly teaches away from Applicant's claimed invention, which clearly teaches a new and non-obvious system whereby a TV viewer can easily *contact a representative* of a displayed advertisement, in a world of ever-changing television advertisements. Hence the updating of "`coupon database memory 142`" in this embodiment [Fig. 4] does *not* have a reasonable expectation of success [In re Vaeck, 947 F.2d 488 20 USPQ2d 1438 (Fed. Cir. 1991)], and is thus invalid in rejecting Applicant's claimed invention [In re Vaeck, 947 F.2d 488 20 USPQ2d 1438 (Fed. Cir. 1991)]. Furthermore, that the suggestion to combine the references should *not* come from the Applicant, was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983).

(2.16) On Pages 6 and 7 of the recent Office Action, Examiner states that it "`would have been obvious to one of ordinary skill in the art at the time of the invention was to modify the television apparatus of Jotikasthira to use the teletext standard to embed a television advertisement data signal` *`because some teletext standards facilitate a higher bit rate relative to other methods and commercially available teletext encoders typically include error detection and correction, resulting in increased data transmission capacity and fewer errors at the receivers`*`, as disclosed by Jones (see Col. 123, lines 15-19 and lines 56-63)`" (Emphasis added).

(2.17) Applicant respectfully disagrees with Examiner's conclusion for the following reasons which are well known in the art, and which are based on sound engineering facts:

2.17.1) The Applicant's claim of teletext is *not* because of the "`higher bit rate relative to other methods`" and "`error detection and correction`" to enable "`increased data transmission capacity and fewer errors`" as surmised by Examiner, but simply covers all versions of teletext standards, analog and digital, including the single VBI line standard of closed captioning versus, for example, the multi-line VBI in the WST teletext standard as cited in **Jones et al** [col. 13, line19; col. 13, line 58-59].

2.17.2) "There are two common methods for encoding the Teletext data into a video stream. The most common is to use the Vertical Blanking Interval or VBI. This is a generally unused space located between the vertical sync pulse and the actual active video picture. Because of the limited number of available lines in the VBI, **the actual amount of data that can be transmitted is limited to about 17.76 Kbits/sec times the number of transmitted lines**. So, if we were to transmit 3 lines of Teletext data per field, that would work out to:

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One horizontal line (525) of data = 37 Bytes
or = 296 bits per line/field
     296
     × 60 (fields per second)
   17,760 bits/sec per line data rate
     × 3 lines/sec
   53,280 bits/sec"
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(Emphasis added) [See article titled: "*What is Teletext*", Marc Schneider, Philips Semiconductor Video Products, June 1994].

2.17.3) Consider the lower throughput of closed captioning (i.e. only via line 21 of the analog VBI signal) for a commonly broadcast <u>30 second TV advertisement</u>. This throughput is about 65 kilobytes per <u>30 second USA advertisement</u> (17,760 x 30 seconds = 532,800 bits, or 66,600 bytes [532,800 / 8 bytes]). In other words, 66,600 closed caption letters can be transmitted during an average <u>30 second USA television advertisement</u>.

2.17.4) This "low" throughput rate of about 65 kilobytes (66,600 / 1024 kilobytes) per <u>30 second TV advertisement</u> **is more than sufficient data-throughput as is required in Applicant's claimed invention**. Referring to Table 1 in section (1.11) above, Applicant traversed a random sampling of USA displayed TV advertisements and listed the type of contact information that Applicant's claimed invention would make available to a viewer. It can be clearly seen that the quantity of required contact information (Total Bytes) is *orders of magnitude lower* than that available in a system which implements the single VBI line of closed captioning, which is the minimum throughput in any analog teletext system.

2.17.5) Hence Examiner's "`evidence of the motivating force which would impel one skilled in the art to do what the patent application has done`" [Ex part Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter., 1993)], i.e. it "`would have been obvious to one of ordinary skill in the art at the time of the invention was to modify the television apparatus of Jotikasthira to use the teletext standard to embed a television advertisement data signal` *`because some teletext standards facilitate a higher bit rate relative to other methods`*" [Emphasis added] [Recent Office Action, Pages 6 and 7] is respectfully invalid.

2.17.6) As to Examiner's reasoning of "`error detection and correction`" [Recent Office Action, Pages 6 and 7], this is a moot point when considering the legislated USA requirements for closed captioning, i.e. Title 47 CFR Part 15, which has been successfully implemented in the USA since July 1, 1993 (see Examiner's cited prior art **Yuen**, col. 10, lines 10-23). It is a moot point because it is a violation of USA law to discriminate against people who have a physical handicap, such as the hearing impaired. Thus Closed Captioning in US television signals has been, and continues to be as error free as the television signal for the rest of the non-handicapped viewing population. Hence Examiner's "`evidence of the motivating force which would impel one skilled in the art to do what the patent application has done`" [Ex part

Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter., 1993)] is respectfully invalid.

(3.0) Applicant now considers the cited prior art **Yuen**: **Yuen** teaches a "`system for communicating information from a television viewer to a central site includes a remote control unit for sending command signals from the viewer` [...] `to a cordless telephone base unit, which is connected to the central site by a public switched telephone network. The cordless telephone base unit initiates a telephone call to the central site and` *`communicates the DTMF tone signals received from the DTMF circuitry in the television or VCR to the central site`*`.`" (Emphasis added) [See Abstract], whereby the "`television or VCR receives a television signal and extracts information related to a product or pay-per-view (PPV) event being advertised on a television program from the vertical blanking interval of the television signal. This` *`information includes the telephone number of the central site`* `used for making the telephone connection as well as identification information for the product or PPV event to be` *`purchased`*`.`" (Emphasis added) [See Abstract].

(3.1) It is obvious that **Yuen** teaches *electronic device communication* between a television device and a central site's electronic device, *using DTMF signals*, for purchasing a service (e.g. "`PPV`") or product advertised on TV, with the phone number for the "`central site`", as well as other relevant data needed to place an order, being extracted from the signal's VBI [See Abstract; Fig. 1; Fig. 5; Fig. 6; Fig. 7; col. 2, lines 5-60; col. 3, lines 29-67; col. 4, lines 1-67; col. 5, lines 1-67, col.6, lines 1-41; col.7, lines 8-67; col. 8, lines 1-7; col. 11, lines 45-67; col. 12, lines 1-67; col. 13, lines 1-57]. The *purchase* of the service / product is immediate, i.e. in *real-time*. This *real-time purchasing* teaches away from Applicant's invention, which allows the viewer to store the pertinent contact information for later use.

(3.2) Nowhere in **Yuen** is it taught that the invention's "`remote control unit can use this information to communicate with a telephone (second electronic device) to` *`contact a representative of the television advertisement`*" [emphasis added], as stated by Examiner in the recent Office Action (Page 18). Clearly **Yuen** teaches the *immediate purchasing* of a product or a PPV event and *not* the capability to "`use this information to communicate with a telephone (second electronic device) to` *`contact a representative of the television advertisement`*".

(3.3) **Yuen** teaches communication between a "`television viewer`" and a "`central site`" *via DTMF*, which is not a "language" that people, i.e. "`a representative of the television advertisement`" understands and / or communicates in. It is well known in the art that a DTMF system is commonly used between electronic devices with a person interacting via a telephone keypad (or a computer) on the one end, and a pertinent telecommunications / computer system on the other end (aka a Touch Tone system).

3.4) "`Dual-tone multi-frequency (DTMF) signaling is used for telephone signaling over the line in the voice-frequency band to the call switching center. The version of DTMF used for telephone tone dialing is known by the trademarked term Touch-Tone (canceled March 13, 1984), and is standardized by ITU-T Recommendation Q.23. Other multi-frequency systems are used for signaling internal to the telephone network.`" (See http://en.wikipedia.org/wiki/Dtmf)

(3.5) Furthermore, Applicant's invention claims that "`contact information`" extracted from the teletext signal could be a web site or a phone number. With respect to the former, i.e. a web site, the advantage of a web site is that a user can interact with the information on the web site in order to "answer" any questions, etc. that she may have. **Yuen** does not teach a viewer interacting with a "`central site`" in this manner.

Furthermore, nowhere in **Yuen** is a web site, or the Internet mentioned as claimed in Applicant's invention, not even in terms of web broadcasting as taught in **Jotikasthira** [see section (1.10) above].

(3.6) Reiterating, **Yuen** teaches simply placing an order for a product or service, and does *not* teach anything about a viewer being able to interact with the "`central site`", other than for making a purchase. The viewer is not even able to ask a question, for example whether or not the product has a warrantee, or if a discount is available, or what the terms are for a refund, etc. A DTMF system is not conducive to easy interaction with "`a representative of the television advertisement`" as claimed by Applicant's invention. This limitation of a DTMF system is well known in the art and clearly teaches away from Applicant's invention.

(3.7) Furthermore, as in the relied upon prior art of **Jones et al**, **Yuen** teaches VBI insertion of purchase data in *real-time* at the TV station, i.e. at the "`network head end 160`" [Fig. 3; col. 8, lines 66-67; col. 9, lines 1-67; col. 10, lines 1-6]. This *real-time* insertion of pertinent advertisement contact data teaches away from Applicant's invention.

(3.8) In conclusion, Applicant respectfully asserts that the cited prior art of **Yuen** teaches away from Applicant's novel and un-obvious results of using a TV signal's associated teletext data to contact a representative of a displayed television advertisement.

Cited Prior Art "Jotikasthira and Jones" and "Jotikasthira, Jones and Yuen" Do Not Contain Any Justification To Support Their Combination, Much Less In The Manner Proposed

(4.0) With regard to the proposed combination of "**Jotikasthira** and **Jones**" [Office Action, Page 6, para. 2-4; Office Action, Page 7, Claim 2; Office Action, Page 11, para. 1-2; Office Action, Page 14, Claim 7; Office Action, Page 15, Claim 20; Office Action, Page 16, Claim 21] and "**Jotikasthira, Jones** and **Yuen**" [Office Action, Page 16, item

7.], it is well known that in order for any prior art references themselves to be validly combined for use in any prior art 35 USC §103 rejection, *the references themselves* (or some other prior art) *must* suggest that they be combined. For example, as was stated in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

> "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

That the suggestion to combine the references should *not* come from the Applicant was forcefully stated in Orthopedic Equipment Co, v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law".

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988):

> "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.... *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis applied]

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

> "In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and / or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis of obviousness unless that logic and reasoning also supplies sufficient impetus to have led to one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing *a prima facie* case of obviousness by some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual to "combine the relevant teachings of the references."... Accordingly an examiner cannot establish obviousness by locating references which describe various aspects

> of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.".

(4.1) In the recent Office Action (Page 18, para. 2), Examiner states that it "would have been obvious to one of ordinary skill at the time the invention was made to combine the teachings of Jotikasthira, Jones et al, and Yuen because it would have made it easier for the user to purchase products that are advertised on television".

(4.2) Applicant respectfully disagrees with this conclusion. As clearly argued above by Applicant in sections (1.3) through (1.13), as well as sections (3.2) through (3.8), that a clear and non-obvious difference *does* exist between contacting a representative of an advertisement and purchasing the advertisement's product or service and therefore Examiner's reasoning is respectfully invalid, i.e. Examiner failed in "providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done" [Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd Pat. App. & Inter., 1993); Eversharp, Inc. v. Fisher Pen Co., 204 F. Supp. 649, 662-63, 132 USPQ (BNA) 423, 434 (N.D. Ill. 1961)].

(4.3) Furthermore Applicant submits that combining **Jotikasthira, Jones et al, Yuen** is not legally justified as argued above in sections (1.3) through (1.13), as well as sections (3.2) through (3.8) and section (4.2), and is therefore improper [In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983), Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988) and Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993)]. Thus Applicant respectfully submits that the rejection on these references be withdrawn.

(4.4) Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner includes an explanation in accordance with M.P.E.P. § 706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A 1985), and Ex parte Levengood, supra, a "`factual basis to support his conclusion that it would have been obvious`" to make the combination.

Conclusion

For all of the above reasons, Applicant respectfully submits that the claims are now in proper form, and that the claims all define patentability over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Conditional Request For Constructive Assistance

Applicant has amended the claims of this application so that they are in proper, definite, and define novel structure, which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, Applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. §2173.02 and §707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very Respectfully

Lester Sussman

Lester Sussman
Applicant Pro Se